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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,852	07/24/2001	Andy T. Huey	CISCO-3572	5861

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EXAMINER	
MARTINEZ, DAVID E	

ART UNIT	PAPER NUMBER
2182	

DATE MAILED: 02/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/912,852	HUEY ET AL.	
	Examiner	Art Unit	
	David E Martinez	2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 December 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6 and 10-17* is/are rejected.

7)☒ Claim(s) *7-9* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 July 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 4 is rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6,415,314 to Fee et al. (Fee).

With regards to claim 4, Fee teaches an ICS [fig 1-3] comprising:

an Ethernet backplane [figs 2, 3 column 5 lines 60-67 (fig 3 element smb10)];

at least one internal ICS chassis occupant operatively coupled to said backplane [figs 1-3 "module" elements, column 4 lines 3-11]; and

wherein said at least one internal chassis occupant is configured to assign IP addresses [column 6 lines 21-43].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, and 10-14, are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication No. US 2004/0015958A1 to Zara et al. (Zara). In view of US Patent No. 6,415,314 to Fee et al. (Fee).

1. With regards to claims 1, 10, and 12, Zara teaches in an Integrated Communications System ("ICS") [paragraph 19 "node has been bolted into a rack" (rack being the ICS)] having an Ethernet backplane [paragraph 19, node in a rack "plugged to power and networking"], a method for assigning an IP address to at least one internal ICS chassis occupant [paragraphs 4 and 19] comprising:

receiving a request for an IP address from a component [paragraphs 4, 15, 17, 19];

determining whether said request was received from one of the said at least one internal chassis occupant [paragraphs 20, 21, checking if the MAC address belongs to the "rack node" (internal chassis occupant)]; and

assigning an IP address to at least one internal chassis occupant if said request was received from one of said at least one internal chassis occupant [paragraph 4, 19 assignment under the condition that the MAC address of the node is allowed to be configured].

Zara teaches all of the above limitations except explicitly for the ICS having an Ethernet Backplane. However, Zara does say the node in a rack being plugged into "power and networking" thus hinting at being plugged into an Ethernet backplane. Fee teaches the use of an Ethernet backplane within a chassis having slot cards for the benefit of being able to manage each of the slot cards from the outside of the chassis [column 2 lines 41-47 and column 5 lines 60-67 (fig 3 element smb10)].

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of both Zara and Fee to provide the ICS with an Ethernet backplane for the benefit of being able to manage each of the slot cards from the outside of the chassis.

2. With regards to claims 2, and 13, Zara teaches the method of Claim 1, wherein the said act of determining whether said request was received from one of the said at least one internal chassis occupant further includes:

querying if a System Switch Processor has recorded a MAC address for the said at least one internal chassis occupant [fig 2 step 230, paragraphs 4 and 20 "the management system will compare the MAC sent by the node with all the MACs that are known"].

3. With regards to claims 3, 11, and 14, Zara teaches the method of Claim 1, further including the act of ignoring said IP address request [fig 2 steps 230 and 235, paragraph 20, if the MAC address is not known, the node within the chassis is not further configured (ignored) and then further diagnosed] and returning to act of receiving a next IP address request if said component is not an internal chassis occupant [paragraph 15, the management module listens for network configuration requests (ip requests) of mac addresses from any node whenever a new node unit is installed].

Claims 5-6, and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,415,314 to Fee et al. (Fee). in view of US Patent Application Publication No. US 2004/0015958A1 to Zara et al. (Zara).

4. With regards to claim 5 Fee discloses a management system being one of the modules, performing module configuration inside of the chassis [column 1 lines 36-42, column 2 lines 28-47], Fee fails to teach the ICS of Claim 4, wherein said at least one chassis occupant is further

configured to receive a request for an IP address from a component, determine whether said request was received from one of said at least one internal chassis occupant, and assign an IP address to at least one internal chassis occupant if said request was received from one of said at least one internal chassis occupant.

However Zara teaches a management system configuring internal rack modules from outside of the chassis configured to:

receive a request for an IP address from a component [paragraphs 4, 15, 17, 19];

determine whether said request was received from one of said at least one internal chassis occupant [paragraphs 20, 21, checking if the MAC address belongs to the "rack node" (internal chassis occupant)]; and

assign an IP address to at least one internal chassis occupant if said request was received from one of said at least one internal chassis occupant [paragraph 4, 19 assignment under the condition that the MAC address of the node is allowed to be configured] all for the benefit of providing a more efficient configuration process that requires less use of skilled workers and increases the reliability of the configuration job and time to deployment components [Zara paragraphs 4-6].

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of both Fee and Zara to receive a request for an IP address from a component, determine whether said request was received from one of said at least one internal chassis occupant, and assign an IP address to at least one internal chassis occupant if said request was received from one of said at least one internal chassis occupant for the benefit of providing a more efficient configuration process that requires less use of skilled workers and increases the reliability of the configuration job and time to deployment components. Furthermore, It would have been

obvious to combine the teachings of both Fee and Zara to have the management system being a module inside as a node inside the chassis for the benefit of system integration which would reduce the cost of purchasing external management equipment.

5. With regards to claim 6, Fee teaches the ICS of Claim 5, wherein said ICS is comprised of eight card slots [fig 1 elements 10, 14].

6. With regards to claim 15, Fee teaches an ICS [fig 1-3] having an Ethernet backplane [figs 2, 3 column 5 lines 60-67 (fig 3 element smb10)], said backplane coupled to at least one internal ICS chassis occupant [figs 1-3 "module" elements, column 4 lines 3-11], wherein said at least one internal chassis occupant having an IP address assignment module ("IPAM") operatively disposed within it [column 6 lines 21-43]. Fee fails to teach a method for assigning an IP address to said at least one internal chassis occupant comprising:

receiving, by said IPAM, a request for an IP address from a component;

determining, by said IPAM, whether said request was received from one of the said at least one internal chassis occupant; and

assigning an IP address, by said IPAM, to at least one internal chassis occupant if said request was received from one of said at least one internal chassis occupant.

However, Zara teaches a management system configuring internal rack modules from outside of the chassis configured to:

receive a request for an IP address from a component [paragraphs 4, 15, 17, 19];

determine whether said request was received from one of said at least one internal chassis occupant [paragraphs 20, 21, checking if the MAC address belongs to the "rack node" (internal chassis occupant)]; and

assign an IP address to at least one internal chassis occupant if said request was received from one of said at least one internal chassis occupant [paragraph 4, 19 assignment

under the condition that the MAC address of the node is allowed to be configured] all for the benefit of providing a more efficient configuration process that requires less use of skilled workers and increases the reliability of the configuration job and time to deployment components [Zara paragraphs 4-6].

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of both Fee and Zara to receive a request for an IP address from a component, determine whether said request was received from one of said at least one internal chassis occupant, and assign an IP address to at least one internal chassis occupant if said request was received from one of said at least one internal chassis occupant for the benefit of providing a more efficient configuration process that requires less use of skilled workers and increases the reliability of the configuration job and time to deployment components. Furthermore, It would have been obvious to combine the teachings of both Fee and Zara to have the management system being a module inside (an "IPAM") as a node inside the chassis for the benefit of system integration which would reduce the cost of purchasing external management equipment.

7. With regards to claim 16, it's of the same scope as claim 2 above thus rejected under the same rationale.

8. With regards to claim 17, it's of the same scope as claim 3 above thus rejected under the same rationale.

Allowable Subject Matter

Claims 7-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 12/22/04 have been fully considered but they are not persuasive.

Applicant argues:

I. "Claim 1 recites 'assigning an IP address to at least one internal chassis occupant if said request was received from one of said at least one internal chassis occupant.' Neither Zara nor Fee teach this limitation. Instead, Zara teaches a method in which a node in a router requests and receives configuration information. See paragraph 17. Zara does not state the information that a template includes. Thus, Zara does not teach assigning an IP address. In fact, the only mention of an IP address in Zara is that a MAC address may be needed to give an asset a correct IP address. See paragraph 4. However, there is no mention of assigning an IP address to an asset. In claim 1, a request for an IP address is received; an available IP address is determined and assigned to the requesting chasis component. This is the actual providing of an IP address for a component in the chasis. Thus, this limitation is not taught by Zara." [Remarks page 6]

II. "Even if Zara and Fee teach the assigning limitation, the Examiner has not provided a proper motivation to combine. The examiner has merely made an assertion that one skilled in the art would combine the references to use the advantages taught by Zara within a router with the backplane. The Examiner has not provided any evidence in the prior art that this assertion is true. The Examiner is required to provide such evidence and without any evidence in the prior art of this motivation the rejection cannot be maintained and must be removed. Thus, Applicants respectfully request claim 1 be allowed." [Remarks page 7].

III. Applicant Remarks Page 8 lines 3-28, directed to claim 15

IV. "Claim 4 recites an ICS that has an ISC occupant that receives requests from other components for IP addresses and assigns IP addresses. Fee does not teach this limitation. Instead, Fee teaches a system for sharing asset information between components in a router. See Col. 2, lines 48-62. There is no mention of components that received request from other components assigned an IP address. Thus, Fee does not teach the limitation of assigning an IP address to an internal component responsive to receiving a request for an IP address." [remarks page 9]

Examiner respectfully disagrees with the above arguments.

With regards to argument I, as disclosed above under the claim 1 rejection, directing the applicant to paragraphs 4 and 19 clearly disclose Zara "assigning an IP address to at least one internal chassis occupant if said request was received from one of said at least one internal chassis occupant". Paragraph 4 clearly states "After the component is physically assembled or installed, it will need to attain a "soft" configuration. The soft configuration includes attributes such as the IP (Internet Protocol) address" and as noted by the applicant, "the MAC (Media Access Control) address of the network interface card may be needed to **give the asset a correct IP address**" (emphasis added) - when you ***give*** the asset a correct IP, you are in fact assigning the asset an IP address. If this is not clear enough, paragraph 19 should clear it when it discloses "The primary NIC will send out a network request (e.g. **DHCP (Dynamic Host Control Protocol) request for an IP address)** (block 220) which may also be accompanied by an explicit request for configuration data" (emphasis added) – anyone skilled in the art can infer from this statement that a node, after sending a DHCP network request for an IP address, will be granted and thus *assigned* an IP address. To further clarify this concept, examiner includes the definition of DHCP as defined by the Microsoft Computer Dictionary as follows.

"**DHCP** *n.* Acronym **D**ynamic **H**ost **C**onfiguration **P**rotocol. A TCP/IP protocol that enables a network connected to the Internet to *assign* a temporary IP address to a host automatically when the host connects to the network."

and thus clearly, Zara anticipating the "assigning an IP address to at least one internal chassis occupant if said request was received from one of said at least one internal chassis occupant" limitation.

With regards to argument II, In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner has in fact provided a motivation to combine which is an advantage found in the actual reference. The question of the assertion to be true is a questioning of the validity of the motivation which is inherently tied to the validity of the Zara reference, which is unquestionable due to the validity of the patent. The motivation to combine is the advantage found in the patent which is presumed to be valid.

With regards to argument III, please see the claim 15 rejection above, and the argument I rebuttal above which discloses how the Zara reference "assigns an IP address to at least one internal chassis occupant if said request was received from one of said at least one internal chassis occupant." As per the motivation to combine, please see the argument II rebuttal above.

With regards to argument IV, In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which

applicant relies (i.e., "an ICS occupant that receives requests from other components for IP addresses", and "assigning an IP address to an internal component responsive to receiving a request for an IP address" are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E Martinez whose telephone number is (703) 305-4890. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A Gaffin can be reached on (703) 308-3301. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Starting October, the examiner can be reached at the new telephone number (571) 272-4152 and new fax number (571) 273-4152.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DEM

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